

REMARKS

Applicants note that claims 15 and 16 stand withdrawn from consideration.

By the above amendment, claim 39 has been amended to recite additional features, as will be discussed below, and claim 41 has been amended in a manner which is considered to overcome the objection to claim 41. Additionally, by the present amendment, new claims 47-57 have been added, wherein claim 47 depends from claim 39 and recites additional features, claims 48-56 correspond to claims 39-47 and are directed to the elected invention of a light transmitting module, while reciting features different from that set forth in claims 39-47 and should be considered herein. Claim 57 is directed to a method and it is assumed that claim 57 is directed to the non-elected invention of claims 15 and 16 and would stand withdrawn from consideration.

With regard to the Examiner's indication that the proposed drawing correction on 25 March 2002 is approved, applicants note that such approved corrected drawing was submitted on December 16, 2002 and submitted herewith is a copy of the corrected Fig. 7 and acceptance thereof is respectfully requested.

As to the objection to claim 41, as pointed out above, claim 41 has been amended to delete the second recitation of "is enabled to pass" and has also been amended to delete an additional recitation, such that claim 41, as amended, should overcome the objection thereto.

The rejection to claims 39-44 under 35 U.S.C. 103(a) as being unpatentable over Blauvelt et al (USPAT 5127072, Blauvelt) in view of Tabuchi (JPPAT 05183185) and the rejection of claims 45 and 46 under 35 U.S.C. 103(a) as being unpatentable over Blauvelt and Tabuchi further in view of Tokuda (USPAT 5608456), such rejections are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the

reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Turning first to Independent claim 39, this claim has been amended to recite the feature that the non-light absorbing portion is of a size sufficient to enable a predetermined mounting accuracy with a predetermined measuring accuracy achievable when the substrate is measured with a camera. That is, as described at page 11, line 12 et. seq. of the specification, in relation to the light transmitting module which includes an edge emitting/incident type light receiving element having a layer disposed on one surface of the substrate in which the layer of the edge emitting/incident type light receiving element includes a light absorbing portion 19 and another portion 24 which is a non-light absorbing portion and which defines a space region of the layer and is referred to in the specification as a marker detecting region 24 which is used for detecting the marker 23, the "size of the marker detecting region 24 is determined, depending on mounting accuracy needed and resolution of an image pickup apparatus used for detecting the marker 23". More particularly, as set forth at page 11, lines 15-24 of the specification, assuming that the mounting accuracy required for the semiconductor light receiving element relative to the signal light 11 is equal to $\pm 1\mu\text{m}$, the measurement accuracy of at least $\pm 0.1\mu\text{m}$ becomes necessary and as the mark of detecting region 24 that allows the accuracy to be insured, a region having a side of $10\mu\text{m}$ or longer ($100\mu\text{m}^2$) becomes necessary when the measurement of the boundary surface or the center of gravity of the marker 23 is executed so as to accomplish the predetermined accuracy by using a camera with the resolution of $1\mu\text{m}$. Thus, as is apparent, the space region 24 or marker detecting region 24 which is a non-light absorbing portion is of a size sufficient to enable a predetermined mounting accuracy with a predetermined measuring accuracy achievable when the substrate is measured with a camera, as now recited in claim 39. Furthermore, it is apparent that the non-light absorbing portion 24 which is also referred to as a marker detecting region enables light to

pass therethrough so as to permit observation of the marker 23 therethrough and provide for proper positioning as described at pages 10 and 11 of the specification, for example. Applicants note that newly presented independent claim 48 and the dependent claims thereof define the feature of a marker (23 as illustrated in Fig. 1) disposed on the one surface of the substrate and that the non-light absorbing portion (24 as illustrated in Fig. 1) enables observation of the marker therethrough (as described at pages 10 and 11) with the dependent claims corresponding to the dependent claims previously submitted. Additionally, applicants note that by the present amendment, a new dependent claim 47 directly depending upon claim 39 has been presented, which recites the feature that at least a part of the light absorbing portion and at least a part of the non-light absorbing portion lie in substantially the same plane as is apparent from Fig. 1 and other figures of the drawings of this application. New dependent claim 56 which depends on claim 48 corresponds to the features of claim 47. Applicants submit that the features as now recited in independent claim 39 as well as new independent claim 48 and the dependent claims thereof are not disclosed or taught in the cited art, as will become clear from the following discussion.

In setting forth the rejection of the claims previously under consideration, i.e. claims 39-46 based primarily on the combination of Blauvelt and Tabuchi, the Examiner recognizes that Blauvelt does not disclose or teach the claimed features of independent claim 39 and therewith the dependent claims. Applicants note that since the same features are present in new independent claim 48 and the dependent claims, Blauvelt also does not disclose or teach such claimed features. More particularly, the states:

Blauvelt does not teach wherein the edge emitting/incident type light receiving element includes a another portion which is a non-light absorbing portion and which defines a space region of the layer. (emphasis added)

The Examiner recognizing the deficiency of Blauvelt in failing to disclose or teach a non-light absorbing portion in addition to the light-absorbing portion refers to Tabuchi contending that such document teaches in Figs. 11 and 20 "wherein a layer of an edge emitting/incidence type light receiving element (1) includes a light absorbing portion (23) and another portion (25) which is a non-light absorbing portion and which defines a space region of the layer." (emphasis added) The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the present invention to use the edge emitting/incidence type light receiving element with Tabuchi in the device of Blauvelt in order to improve the coupling efficiency with an optical fiber as stated by Tabuchi in the Object section. Applicants submit that the Examiner has mischaracterized the disclosure of Tabuchi in relation to the claimed invention, and has engaged in an improper hindsight reconstruction analysis utilizing the principle of "obvious to try" which is not the standard of 35 U.S.C. 103. See In re Fine, supra.

Turning to Tabuchi, while the Examiner refers to a light absorbing portion (23) and "another portion (25) which is a non-light absorbing portion and which defines a space region of the layer" (emphasis added), applicants submit that such a description of the portion (25), as contended by the Examiner, is not found in Tabuchi. Applicants note that the copy of Tabuchi forwarded by the Examiner includes an English language translation wherein the portion (25) is described as a "insulator" and is not described as being a non-light absorbing portion nor that such defines a space region of the layer. Rather, the disclosure of Tabuchi is that the portions 22 and 24 above and below the light absorption layer 23 are "light-guide layers" and such layers 22 and 24 appear to be delimited above and below by the electrode 26 and a substrate 21 and electrode 27, while being delimited on the sides thereof by the insulator 25. Since the layers 22 and 24 are described as light guiding layers with the operation ther of being illustrated in various figures, applicants

submit that describing the delimiting insulator 25 as a non-light absorbing portion which defines a space region of the layer is contrary to the disclosure of Tabuchi. Furthermore, applicants submit that there would be no reason, in the sense of 35 U.S.C. 103 to utilize an insulator 25 as disclosed by Tabuchi in the arrangement of Blauvelt in the sense of 35 U.S.C. 103. Thus, applicants submit that claim 39, prior to the amendment submitted herewith patentably distinguish over this proposed combination of references of Blauvelt and Tabuchi in the sense of 35 U.S.C. 103, and the Examiner's contention concerning obviousness has no basis in the disclosures of the individual references taken alone or in combination thereof. See, for example, In re Lee, supra.

With regard to the features of claim 39, as amended, even assuming arguendo that the insulator 25 could be considered to be a non-light absorbing portion, there is no disclosure or teaching in Blauvelt or Tabuchi that the non-light absorbing portion is of a size sufficient to enable a predetermined mounting accuracy with a predetermined measuring accuracy achievable when the substrate is measured with a camera. Thus, not only does the combination fail to provide a non-light absorbing portion arranged in the manner defined, there is no disclosure or teaching in the cited art of the size of the non-light absorbing portion as now recited in claim 39. Likewise, with respect to independent claim 48, there is no disclosure or teaching in Blauvelt or Tabuchi of a marker being disposed on one surface of the substrate and the non-light absorbing portion enabling observation of the marker therethrough. It is apparent that such structural features are not disclosed or taught by the references taken alone or in any combination thereof. Furthermore, it is apparent that as defined in the dependent claims and including newly added claims 47 and 56, there is no disclosure or teaching in the cited references with regard to the light absorbing portion and the non-light absorbing portion having parts thereof substantially in a same plane or the other features as recited in the dependent claims.

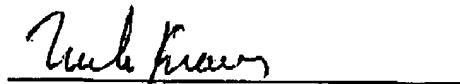
thereof. Thus, applicants submit that independent claims 39 and 48 and the dependent claims patentably distinguish over the proposed combination of Blauvelt and Tabuchi in the sense of 35 U.S.C. 103 and all claims should be considered allowable thereover.

With respect to the addition of Tokuda in combination with Blauvelt and Tabuchi, applicants submit that Tokuda fails to overcome the deficiencies of the aforementioned references in relation to the light-absorbing portion and the non-light absorbing portion. Furthermore, it is apparent that there is no disclosure or teaching in Tokuda of the size of the non-light absorbing portion or that such non-light absorbing portion enables observation therethrough of a marker which is disposed on the substrate. Thus, applicants submit that claims 39 and 48 and the dependent claims also patentably distinguish over this proposed combination of references in the sense of 35 U.S.C. 103, and all claims should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims under consideration in this application should be considered allowable at this time and favorable action with regard thereto is respectfully requested.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.38228CX1) and please credit any excess fees to such deposit account.

Respectfully submitted,



Melvin Kraus
Registration No. 22,466
ANTONELLI, TERRY, STOUT & KRAUS, LLP

MK/cee
(703) 312-6600

Appl. No. 09/485,852
Amtd. Dated December 1, 2003
Reply to Office action of Aug. 1, 2003
Replacement Sheet

4 / 6

FIG. 7

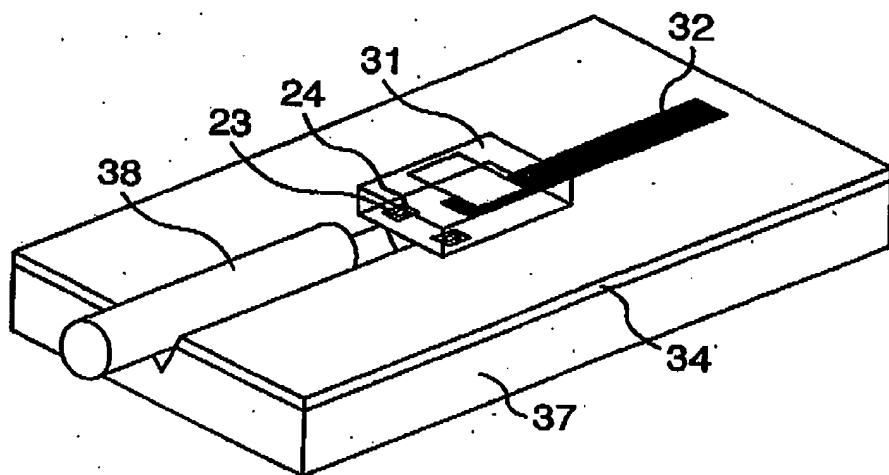


FIG. 8

